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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,049	06/27/2003	Brian Ernest McMahon	DN2001105D01	7909
27280	7590	06/28/2005	EXAMINER	
THE GOODYEAR TIRE & RUBBER COMPANY INTELLECTUAL PROPERTY DEPARTMENT 823 1144 EAST MARKET STREET AKRON, OH 44316-0001			MACKEY, JAMES P	
			ART UNIT	PAPER NUMBER
			1722	

DATE MAILED: 06/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/608,049

Applicant(s)

MCMAHON ET AL.

Examiner

James Mackey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4 and 5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 4 and 5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>6/27/03; 6/28/04</u> | 6) <input type="checkbox"/> Other: ____ |

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1. The disclosure is objected to because of the following informalities: Applicant should update the status of the parent application cited at the beginning of the specification, including the patent number.

Appropriate correction is required.

2. The use of the trademarks “Permafoam”, “Teflon”, “DYN-OH-COAT”, “McLube” and “Pam” has been noted in this application. Each trademark should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 is indefinite in that the claim depends from itself. For purposes of examination, the claim will be interpreted as depending from claim 4.

Claim 5 is indefinite in that it recites improper Markush language “selected from the group including”; note that the use of --selected from the group consisting of-- is the proper Markush language. See MPEP § 2173.05(h)(I).

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Claim 5 is indefinite in that it recites trademarks used as a limitation to identify or describe a particular material or product, which is improper for the claims and which renders the claim of indefinite scope; see MPEP § 2173.05(u). See also *Ex parte Simpson*, 218 USPQ 1020.

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 4 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hoesman (U.S. Patent 4,734,232; col. 2, lines 64-68, and col. 4, lines 1-3).

Hoesman teaches a rim 11 for holding a tire during molding of foam therein, the rim comprising an exterior surface having a release agent coating of silicon thereon to assure release of the tire having foam therein when the tire is removed from the rim.

7. Claim 4 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lambe (U.S. Patent 3,022,810; col. 4, lines 43-46).

Lambe teaches a rim 13 for holding a tire during molding of foam therein, the rim comprising an exterior surface having a lubricant coating thereon to prevent adhering of the foam to the rim.

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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9. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

10. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hoesman (U.S. Patent 4,734,232; col. 2, lines 64-68, and col. 4, lines 1-3).

Hoesman discloses a rim 11 for holding a tire during molding of foamed urethane therein, the rim comprising an exterior surface having a release agent coating of silicon thereon to assure release of the tire having foamed urethane therein when the tire is removed from the rim. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Hoesman by providing the release agent coating as either a fluorinated thermoplastic (such as PTFE) or a "baked on coating", since such are recognized equivalent release agent coatings and

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since such coatings would have been expected to perform equally well as the “painted or sprayed” silicon release agent coating disclosed in Hoesman.

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lambe (U.S. Patent 3,022,810; col. 4, lines 43-46).

Lambe teaches a rim 13 for holding a tire during molding of foam therein, the rim comprising an exterior surface having a lubricant coating thereon to prevent adhering of the foam to the rim. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Lambe providing the lubricant coating as either a fluorinated thermoplastic (such as PTFE) or a “baked on coating”, since such are recognized equivalent lubricant coatings and since such coatings would have been expected to perform equally well as the wax lubricant coating disclosed in Lambe.

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

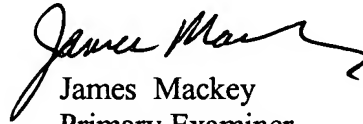
Robbins (U.S. Patent 2,854,692; col. 4, lines 68-74) discloses the use of a mold lubricant for eliminating binding between a tire and a cylindrical rim 17. Bubik et al. (U.S. Patent 5,098,509 ; col. 3, lines 30-34) discloses an annular rim 30, 31 including a protective rubber outer coating.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Mackey whose telephone number is 571-272-1135. The examiner can normally be reached on M-F, 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duane Smith can be reached on 571-272-1166. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


James Mackey
Primary Examiner
Art Unit 1722
6/24/05

jpm
June 24, 2005